

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86135390
LAW OFFICE ASSIGNED	LAW OFFICE 114
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant requests that the Examining Attorney reconsider the final refusal in this matter. Applicant refers to its prior submitted response to office action and reiterates the arguments made therein. Specifically, Applicant submits that the applied for mark and the cited mark are different in sight, sound and overall commercial impression. Specifically, the examining attorney did not address Applicant's arguments pertaining to the addition of the house mark SUREFIRE in this case. As previously argued by Applicant, the Board in the cited case of <i>In re Dennison Mfg. Co.</i>, 229 USPQ 141 (TTAB 1976) acknowledged the rule cited by the Examining Attorney that the addition of a house mark increases confusion is not a blanket rule. The Dennison court stated that "the addition of a trade name or house mark may be sufficient to render the marks as a whole distinguishable." This concept was upheld generally by the court in <i>In re Bed &amp; Breakfast Registry</i> 791 F3d 157, 229 USPQ 818 and was specifically by the court in <i>Rockwood Chocolate Co. v. Hoffman Candy Co.</i>, 372 F2d 552, 152 USPQ 599 (CCPA 1967). The totality of the differences of the marks must be taken into consideration in determining a likelihood of confusion. Applicant submits that the marks, when viewed in their entireties are completely different. The house mark SUREFIRE is a well recognized mark, as is evidenced by the multitude of U.S. trademark registrations for the SUREFIRE mark (2,931,256; 2,657,142; 3,820,152; 4,249,093; 4,197,929; 4,249,101; 4,197,940; 4,252,902; and 4,488,953) and the length of time the SUREFIRE company has been in the business of making flashlights (since at least 1985, <a href="http://en.wikipedia.org/wiki/SureFire">http://en.wikipedia.org/wiki/SureFire</a>) . The addition of the word SUREFIRE would be an immediate source identifier to a potential consumer and, as such, would be the dominant feature of the SUREFIRE MAXIMUS mark. Moreover, the Board in <i>Dennison</i> noted that if the common word was descriptive in nature, then the addition of the house mark would be more likely to distinguish the marks. Here, the common word "maximus", although having no specific English dictionary definition, means "greatest" or "largest" in Latin, and, accordingly, would bring to mind the feature of providing maximum light as applied to the subject goods. Thus, the shared element is descriptive, and as such the addition of the SUREFIRE name would clearly distinguish the marks in the marketplace. Applicant requests that the Examining Attorney reconsider the strength of the SUREFIRE mark as a source identifier and acknowledge that the word "maximus" that the examiner considered to be the dominant feature of the two marks is actually descriptive in nature since it means "largest" or "greatest" in Latin. Accordingly, the most distinguishable feature of either mark is SUREFIRE, which clearly identifies the SureFire company as the source of the products being sold under the mark, thereby eliminating any potential confusion in the marketplace.</p>	
SIGNATURE SECTION	

<b>RESPONSE SIGNATURE</b>	/Janet Kaufman/
<b>SIGNATORY'S NAME</b>	Janet Kaufman
<b>SIGNATORY'S POSITION</b>	Attorney for Applicant, California Bar Member
<b>SIGNATORY'S PHONE NUMBER</b>	858-775-2140
<b>DATE SIGNED</b>	12/13/2014
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Sat Dec 13 16:08:51 EST 2014
<b>TEAS STAMP</b>	USPTO/RFR-68.105.116.41-2 0141213160851076088-86135 390-5006652c4fe4e5571c465 294dbb59d5d116c4c6435bab2 c306c96a66dee8a6ddd76-N/A -N/A-20141213154726333870

## Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **86135390** has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

Applicant requests that the Examining Attorney reconsider the final refusal in this matter. Applicant refers to its prior submitted response to office action and reiterates the arguments made therein. Specifically, Applicant submits that the applied for mark and the cited mark are different in sight, sound and overall commercial impression. Specifically, the examining attorney did not address Applicant's arguments pertaining to the addition of the house mark SUREFIRE in this case. As previously argued by Applicant, the Board in the cited case of *In re Dennison Mfg. Co.*, 229 USPQ 141 (TTAB 1976) acknowledged the rule cited by the Examining Attorney that the addition of a house mark increases confusion is not a blanket rule. The Dennison court stated that "the addition of a trade name or house mark may be sufficient to render the marks as a whole distinguishable." This concept was upheld generally by the court in *In re Bed & Breakfast Registry* 791 F3d 157, 229 USPQ 818 and was specifically by the court in *Rockwood Chocolate Co. v. Hoffman Candy Co.*, 372 F2d 552, 152 USPQ 599 (CCPA 1967). The totality of the differences of the marks must be taken into consideration in determining a likelihood of confusion.

Applicant submits that the marks, when viewed in their entireties are completely different. The house mark SUREFIRE is a well recognized mark, as is evidenced by the multitude of U.S. trademark registrations for the SUREFIRE mark (2,931,256; 2,657,142; 3,820,152; 4,249,093; 4,197,929; 4,249,101; 4,197,940; 4,252,902; and 4,488,953) and the length of time the SUREFIRE company has been in the business of making flashlights (since at least 1985, <http://en.wikipedia.org/wiki/SureFire>) . The addition of the word SUREFIRE would be an immediate source identifier to a potential consumer and, as such, would be the dominant feature of the SUREFIRE MAXIMUS mark. Moreover, the Board in Dennison noted that if the common word was descriptive in nature, then the addition of the house mark would be more likely to distinguish the marks. Here, the common word "maximus", although having no specific English dictionary definition, means "greatest" or "largest" in Latin, and, accordingly, would bring to mind the feature of providing maximum light as applied to the subject goods. Thus, the shared element is descriptive, and as such the addition of the SUREFIRE name would clearly distinguish the marks in the marketplace. Applicant requests that the Examining Attorney reconsider the strength of the SUREFIRE mark as a source identifier and acknowledge that the word "maximus" that the examiner considered to be the dominant feature of the two marks is actually descriptive in nature since it means "largest" or "greatest" in Latin. Accordingly, the most distinguishable feature of either mark is SUREFIRE, which clearly identifies the SureFire company as the source of the products being sold under the mark, thereby eliminating any potential confusion in the marketplace.

#### **SIGNATURE(S)**

##### **Request for Reconsideration Signature**

Signature: /Janet Kaufman/ Date: 12/13/2014

Signatory's Name: Janet Kaufman

Signatory's Position: Attorney for Applicant, California Bar Member

Signatory's Phone Number: 858-775-2140

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86135390

Internet Transmission Date: Sat Dec 13 16:08:51 EST 2014

TEAS Stamp: USPTO/RFR-68.105.116.41-2014121316085107

6088-86135390-5006652c4fe4e5571c465294db

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